

REMARKS

The Examiner is thanked for the performance of a thorough search. By this response, Claims 1, 30, 38, 130, 134, and 148 have been amended. No claims have been added or canceled. Hence, Claims 1–4, 6–9, 11, 16, 25, 30, 31, 33, 36–39, 41–44, 46, 51, 60, 65, 66, 68, 71–74, 76, 77, 84, 85, 87–89, 98, 101, 116, 117, 119, and 124–156 are pending in this application.

All issues raised in the Office Action are addressed hereinafter.

I. SCHEDULED INTERVIEW

Applicants have scheduled a telephone interview with the Examiner for February 1, 2010 at 2:00 P.M. EST to discuss the amendments and arguments presented in this response. For compact prosecution, Applicants respectfully request that the Examiner wait to respond to these amendments and remarks until after the scheduled telephone interview.

II. ADDED CLAIMS / AMENDMENTS

The added claims and amendments to the claims do not add any new matter to this application and are supported by the Specification as originally filed. The amendments to the claims, which may broaden certain aspects of the original claims, improve the readability and clarity of the claims.

III. CLAIM OBJECTIONS

The Office Action objected to Claims 130 and 148 for informalities. The present amendments fully address the objection. Removal of the objection is respectfully requested.

IV. CLAIM REJECTIONS BASED ON 35 U.S.C. § 103

Claims 1-4, 6, 8-9, 11, 16, 31, 33, 36-39, 41, 43-44, 46, 51, 66, 68, 71-74, 77, 84-85, 88-89, 98, 101, 116-117, 119, 124-125, 127, 129-132, 135-143, 145, 147-150 and 153-156 were

rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent Publication 2002/0131404 to Mehta et al. ("Mehta") in view of PCT WO 99/31610 to Leveridge ("Leveridge"). Applicants traverse the rejection. Reconsideration is respectfully requested.

Claims 7, 42, 76, 87, 126, 128, 144 and 146 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mehta in view of Leveridge as applied above, further in view of U.S. Patent No. 6,873,691 to Malik ("Malik"). Applicants traverse the rejection. Reconsideration is respectfully requested.

Claims 25, 60, 133 and 155 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mehta in view of Leveridge as applied above, in view of U.S. Patent No. 5,502,636 to Clarke ("Clarke"). Applicants traverse the rejection. Reconsideration is respectfully requested.

Claims 30, 65, 134 and 152 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mehta in view of Leveridge as applied above and further in view of U.S. Patent No. 6,704,612 to Hahn-Carlson ("Hahn-Carlson"). Applicants traverse the rejection. Reconsideration is respectfully requested.

INDEPENDENT CLAIM 1

The method of Claim 1, as set forth in the listing of claims, recites among other elements:

based at least on [an] intercepted message, software managed by
the third party performing the steps of . . . before the
content is delivered to the requestor:
**determining whether the requestor is in a first set of
users or is in a second set of users, wherein each
user in the first set of users is required to pre-
authorize payment for the content, wherein each
user in the second set of users is not required to
pre-authorize payment for the content;**
in response to the determining that the requestor is in the
first set of users, sending the requestor a payment
authorization request message;

in response to detecting that the requestor has authorized payment for the content, retransmitting the message to allow the requestor to obtain the content;

Thus, Claim 1 recites a method in which a user may be in one of **two different sets of users**—a set of users that are **not required to pre-authorize payment for a particular item** of content and a set of users that **are required to pre-authorize payment for that same item** of content. The cited references fail to teach or suggest such a method.

The Office Action alleges that *Leveridge*'s abstract describes “determining whether [a] requestor is required to pre-authorize payment for . . . content” and “sending the requestor a payment authorization message.” However, *Leveridge*'s abstract does not describe “first set of users [that] is required to pre-authorize payment for the content” and a “second set of users [that] is not required to pre-authorize payment for the [same] content.” Nor does any other aspect of *Leveridge* describe the above quoted features. Since those two groups of users do not exist in *Leveridge*, *Leveridge* cannot possibly disclose determining to which of those two sets a particular user belongs.

Rather, *Leveridge*'s proxy CGI appears to send “an HTML form displaying the price to be charged [and] **requesting confirmation** of the order” to **all users requesting a particular item of content**. *Leveridge* at 14, lines 3–5. Since *Leveridge* treats all users the same way with respect to requesting confirmation, *Leveridge* does not even suggest a method that responds differently depending on which group a particular user belongs to. Claim 1 clearly requires users to be treated differently based on the set of users to which they belong, as set forth in the following express limitations:

in response to the determining that the requestor is in the
first set of users, sending the requestor a payment
authorization request message;
in response to detecting that the requestor has authorized
payment for the content, retransmitting the message
to allow the requestor to obtain the content;

Thus, there would not be, for any given item of content handled by *Leveridge*'s proxy CGI, a "first set of users [that] is required to pre-authorize payment for the content" and a "second set of users [that] is not required to pre-authorize payment for the [same] content." Accordingly, *Leveridge* cannot teach or suggest "determining whether the requestor is in a first set of users or is in a second set of users" as recited in Claim 1.

The Office Action furthermore admits that *Mehta* does not teach or suggest anything about user pre-authorization of payment. Office Action at 5. For at least the foregoing reasons, then, the combination of *Mehta* and *Leveridge* fails to provide the complete subject matter recited in independent Claim 1. Therefore, the combination of *Mehta* and *Leveridge* would not have rendered Claim 1 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

INDEPENDENT CLAIM 116

Claim 116 recites, among other elements:

intercepting a message that has been sent from a provider to a
requestor, prior to said message being received by the
requestor;
...
wherein **the message includes a price at which the provider is
willing to provide content included in the message;**
based at least on the intercepted message, software managed by [a]
third party . . . :
reading the price from the message;

sending billing data to a billing service, the billing data being
based on the price that was extracted from the message . . .

Thus, Claim 116 features a message that comprises **both content and a price** for the content.

The cited references do not teach or suggest such a message.

The Office Action appears to allege that *Mehta* describes such a message in FIG. 11F and FIG. 11G. The Office Action is incorrect. These cited figures show HTML pages that indicate prices for applications. Presumably, the Office Action is equating these web pages with messages. However, the prices are for applications that the user may download at a later time via links to other URLs, not for applications **included in the same message** (e.g. in the same HTML page as the depicted prices). Thus, the depicted HTML pages are not “message[s] [that] includes a price at which the provider is willing to provide content included in the message,” as recited in Claim 116. Nor does any other message described in *Mehta* appear to comprise both content and a price for the content.

The Office Action also appears to allege that *Leveridge* describes such a message on page 2. The Office Action is again incorrect. The Office Action appears to be referring to *Leveridge*’s discussion of another system described in WO 97/03410. This other system is described as having been capable of extracting transaction information from communication between a customer and vendor. Yet, **there is no evidence that the messages from which this system extracted transaction information would have included anything other than the transaction information.** For example, there is no evidence that the message from which the transaction information is extracted would have included the actual content being purchased. Accordingly, this system described on page 2 of *Leveridge* does not describe “a message [that]

includes a price at which the provider is willing to provide content included in the message,” as recited in Claim 116.

Nor does *Leveridge* appear to describe any other message that is similar to the message recited in Claim 116. For example, *Leveridge* describes a message that includes a price code. *Leveridge* at 11–12. However this message is a HTTP 402 error message, and does not include the actual content being billed. *Id.* As another example, *Leveridge* describes a price code embedded in an image tag within HTML content. *Leveridge* at 17, lines 3–5. However, like the prices in the above-discussed HTML pages of *Mehta*’s FIG. 11F and FIG. 11G, this image merely indicates to the user the price the user would have to pay to download other content, not the price of the HTML page in which the price code is embedded. *Id.*

For at least the foregoing reasons, then, the combination of *Mehta* and *Leveridge* fails to provide the complete subject matter recited in independent Claim 116. Therefore, the combination of *Mehta* and *Leveridge* would not have rendered Claim 116 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

REMAINING CLAIMS

Each of the remaining claims not discussed above recites or depends from a claim that recites at least one of the above-discussed features. As discussed above, the combination of *Mehta* and *Leveridge* fails to teach or suggest the above-discussed features. The remaining cited references also do not appear to teach, and are not alleged to teach, the above-discussed features. Consequently, no combination of *Mehta* and *Leveridge* with the other cited reference(s) teaches or suggests the complete subject matter of the remaining claims.

Moreover, the remaining pending claims include additional elements that the cited references also do not teach or suggest. However, to expedite prosecution, arguments concerning these additional elements are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and these additional novel elements.

V. CONCLUSION

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact Applicants' representative by telephone relating to any issue that would advance examination.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a check for the petition for extension of time fee and other applicable fees is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,
HICKMAN PALERMO TRUONG & BECKER LLP

Date: January 19, 2011

/KarlTRees#58983/
Karl T. Rees, Reg. No. 58,983

2055 Gateway Place, Suite 550
San Jose, CA 95110
(408) 414-1233
Facsimile: (408) 414-1076